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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,476	12/17/2003	Marilyn S. Bullock	014033-000006	1475

24239 7590 12/13/2007		EXAMINER
MOORE & VAN ALLEN PLLC		MURDOUGH, JOSHUA A
P.O. BOX 13706		
Research Triangle Park, NC 27709		

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/707,476	BULLOCK ET AL.
	Examiner	Art Unit	
	Joshua Murdough	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _29 March 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-30_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-30_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _29 March 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-SB/08)
   Paper No(s)/Mail Date _3/19/2004_.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Examiner's Notes

1.   The Examiner has referenced three press releases regarding the same product. These

press releases (From Panda Security Internacional; dated Jan. 17, 2001; Nov. 15, 2001; and Nov.

26, 2002) all reference a single embodiment ("Panda ActiveScan" 4.0), but when cited, the

Examiner has referred to them chronologically as "Release 1," "Release 2," and "Release 3."

(MPEP 2131.01)

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

2.   Claims 13-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter. These claims recite a "computer program product" and do not

positively recite that the instructions are stored on a tangible device nor are they used to cause a

device to operate. Therefore, the Examiner has to interpret these claims as being to software,

which is per se, non-statutory. Wording, such as, "A computer readable medium containing

instructions that when executed cause a computer to..." would allow these claims to be

interpreted as being statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panda ActiveScan in view of Dent (6,311,171).

3.   As to claims 1, 13, and 22; Panda ActiveScan shows:

A method of disabling malicious code residing on a customer computer system in

association with providing on-line financial services to a customer through a

network, the method comprising:

presenting to the customer an option to perform a scan of the customer computer

system for the malicious code (Release 3, Paragraph 7);

executing, at least in part by activation over the network (Release 3, Paragraph 5) and

upon receiving from the customer a selection of the option to perform the scan,

computer program instructions for performing the scan, the computer program

instructions being directed to detection and disablement of the malicious code

(Release 3, Paragraph 3);

4.   Panda ActiveScan does not expressly show:

authenticating the customer for the on-line financial services;

providing the on-line financial services to the customer.

5.   Dent shows authenticating a customer through use of public key/private key encryption in

order to process an online financial transaction (Figure 2). It would have been obvious to one of

ordinary skill in the art at the time of the invention to have modified the invention Panda

ActiveScan to reside on the website of a financial institution, because webmasters were invited

to include the functionality (Panda ActiveScan; Release 3, Paragraph 7) and security at a

financial institution is a major concern.

6.　　As to claim 2, 14, and 23; Panda ActiveScan further shows:

　　　　the executing of the computer program instructions further comprises downloading

　　　　　　the computer program instructions to the customer computer system (Release 1,

　　　　　　Paragraphs 8-10).

7.　　As to claim 3, 15, and 24; Panda ActiveScan further shows:

　　　　the executing of the computer program instructions is accomplished at least in part

　　　　　　through the use of an ActiveX control (Release 1, Paragraph 7).

8.　　As to claim 4, 16, and 25; Panda ActiveScan further shows:

　　　　the computer program instructions are operable to perform signature-based detection

　　　　　　of the malicious code (Release 2, Paragraph 7).

9.　　As to claim 5, 17, and 26; Dent, in the combination above, shows:

　　　　the computer program instructions are operable to perform integrity checking

　　　　　　(Through keys, as mentioned; Figure 2).

10.　　As to claim 6, 18, and 27 Panda ActiveScan further shows:

　　　　the computer program instructions are operable to perform non-integrity-based

　　　　　　unknown malicious code detection (Heuristic scan engine; Release 3, Paragraph

　　　　　　2).

11.　　As to claim 7, 19, and 28; Panda ActiveScan further shows:

　　　　the computer program instructions are operable to perform signature-based detection

　　　　　　of the malicious code (Release 2, Paragraph 7).

12.   As to claim 8, 20, and 29; Dent, in the combination above, shows:

> the computer program instructions are operable to perform integrity checking
>
> (Through keys, as mentioned; Figure 2).

13.   As to claim 9, 21, and 30; Panda ActiveScan further shows:

> the computer program instructions are operable to perform non-integrity-based
>
> unknown malicious code detection (Heuristic scan engine; Release 3, Paragraph
>
> 2).

14.   As to claim 10, Panda ActiveScan shows:

> Apparatus for disabling malicious code residing on a customer computer system in
>
> association with providing on-line financial services to a customer through a
>
> network, the apparatus comprising:
>
> means for executing, at least in part by activation over the network (Release 3,
>
> Paragraph 5), computer program instructions for performing a scan for the
>
> malicious code, the computer program instructions being directed to detection and
>
> disablement of the malicious code (Release 3, Paragraph 3);

15.   Panda ActiveScan does not expressly show:

> means for authenticating the customer for the on-line financial services;
>
> means for providing the on-line financial services to the customer.

16.   Dent shows authenticating a customer through use of public key/private key encryption in

order to process an online financial transaction (Figure 2). It would have been obvious to one of

ordinary skill in the art at the time of the invention to have modified the invention Panda

ActiveScan to reside on the website of a financial institution, because webmasters were invited

to include the functionality (Panda ActiveScan; Release 3, Paragraph 7) and security at a

financial institution is a major concern.

17.   As to claim 11, Panda ActiveScan further shows:

the means for executing the computer program instructions further comprises means

for downloading the computer program instructions to the customer computer

system (Release 1, Paragraphs 8-10).

18.   As to claim 12, Panda ActiveScan further shows:

the means for executing the computer program instructions further comprises an

ActiveX control (Release 1, Paragraph 7).

19.   While treated together and the method limitations directly addressed, it is recognized that

claims 13-21 are to the software and 22-30 are to the system.   The software instructions claimed

would cause a computer to perform the noted method if they were caused to execute. Also, the

system claimed would also need to be present to perform the associated method.

20.   Applicant(s) are reminded that optional or conditional elements (*e.g.* claims 4-9 which

recite "the computer program instructions are operable to perform...") do not narrow the claims

because they can always be omitted. See *e.g.* MPEP §2106 II *C.*: "Language that <u>suggests or</u>

<u>makes optional</u> but does not require steps to be performed or does not limit a claim to a particular

structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"; and *In*

re Johnston, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic

precision, optional elements do not narrow the claim because they can always be omitted.").

21.   If a positive recitation is desired and if Applicant(s)' original specification supports such

an amendment, the Examiner respectfully suggests amending the claim to recite, *e.g.* "the

computer program instructions perform..."

Conclusion

22.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

23.   Hicks (7,302,706) provides more details about scanning for viruses across a network.

24.   Sobel (2006/0130139) shows more of the possible security methods possible from the

client side.

25.   Alagna (2004/0098607) describes a method, system, and computer software for providing

security for a financial transaction performed online.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joshua Murdough whose telephone number is (571) 270-3270.

The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough

ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600